

**Notice of Allowability**

Application No.

09/518,813

Examiner

Jon D. Epperson

Applicant(s)

JOSEPH ET AL

Art Unit

1639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 11/18/04.
2. ☒ The allowed claim(s) is/are 58-65 (renumbered 1-8).
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All    b) ☐ Some\*    c) ☐ None    of the:
    - 1: ☒ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date \_\_\_\_\_
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of the Application***

1. Receipt is acknowledged of a responsive amendment, which was dated on November 18, 2004.

### ***Status of the Claims***

2. Claims 1, 7, 8, 15 and 58-65 were pending. Applicants canceled claims 1, 2, 7, 8 and 15. In addition, applicants amended claims 58 and 62. Therefore, claims 58-65 are currently pending.

### ***Reasons for Allowance***

3. The following is the Examiner's statement of reasons for allowance:

The claims are allowed for the reasons that the prior art of record does not teach or fairly suggest applicants' claimed method for screening proteins and polypeptides using and in vitro "cell free" process.

The Examiner also again acknowledges Applicants claims for both domestic and foreign priority. Applicants requested a correction of their domestic priority as claimed by Applicant on the corrected filing receipt (e.g., see 12/17/04 submission). The Office denied this request because according to OIPE, "The application(s) to which priority is claimed were filed over a year prior to the filing date of this application. Therefore, the referenced applications(s) cannot be claimed as domestic or foreign priority" (e.g., see 1/4/05 Action, page 2). This was in error. The present application was filed as a continuation application of an international application under 35 C.F.R. § 1.53(b) and 35 U.S.C. § 111 and MPEP § 1895.01 to obtain the PCT filing date as the effective date by virtue of 35 U.S.C. § 363 (e.g., see 3/3/2000 Transmittal of New

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Application). MPEP § 1895 states in pertinent part, "It is possible to file a U.S. national application under 35 U.S.C. 111(a) during the pendency (prior to the abandonment) of an international application which designates the United States without completing the requirements for entering the national stage under 35 U.S.C. 371(c). The ability to take such action is based on provisions of the United States law ... 35 U.S.C. § 363 ... [which] requires the later application to be filed before the patenting or abandonment of or termination of proceedings of the first application." This requirement appears to be met as PCT/GB98/026498 was "pending" at the time the present application was filed and designated the United States. OIPE has been notified to this end and another Request for Corrected Filing Receipt has been entered (e.g., see 1/31/05 Request).

### *Salutation*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon D Epperson whose telephone number is (571) 272-0808. The examiner can normally be reached Monday-Friday from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571) 272-0811. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jon D. Epperson, Ph.D.  
February 9, 2005

BENNETT, CELSA  
FEB 10 2005  
